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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTONIO VITTI and JOHN VITTI

Appeal 2016-004599[1]
Application 13/178,461[2]
Technology Center 3600

Before MICHAEL C. ASTORINO, NINA L. MEDLOCK, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–46. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Our decision references Appellants' Appeal Brief ("App. Br.," filed October 14, 2014) and Reply Brief ("Reply Br.," filed February 19, 2015), and the Examiner's Answer ("Ans.," mailed December 19, 2014), and Final Office Action ("Final Act.," mailed September 13, 2013).
[2] Appellants identify Merchant Atlas, Inc. as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellants' claimed invention "relates to a system and method for generating vouchers for a user using a mobile device and in particular to a mobile voucher system that provides provable in-store redemption, city wide vouchers, cross selling of vouchers, partial redemptions and proximity based pricing" (Spec. 1, ll. 7–10).

Claims 1, 17, and 33 are the independent claims on appeal. Claims 1 and 17, reproduced below, are illustrative of the claimed subject matter:

> 1. A mobile voucher system, comprising:
>
> one or more consumer computing devices;
>
> a mobile voucher unit that is capable of being connected to and interacting with each of the one or more consumer computing devices over a link;
>
> the mobile voucher unit having a mobile voucher manager that creates a new deal having a purchase price, a redemption value and a discount of the new deal for a particular merchant, that syndicates the new deal to a plurality of consumers to determine a level of interest of the plurality of consumers wherein an interested user participates in the new deal, that presents the new deal to the particular merchant, for approval, when a deal threshold is met and, when the merchant accepts the new deal, that provides a digital voucher to the consumer computing device of each user who participated in the new deal; and
>
> each consumer computing device that displays the digital voucher received from the mobile voucher unit and that allows the user of the consumer computing device to redeem the digital voucher at the particular merchant and prove a[ ] merchant in-store redemption.

17. A method for providing a mobile voucher with one or more consumer computing devices and a mobile voucher unit that is capable of being connected to and interacting with each of the one or more consumer computing devices over a link, the method comprising:

creating, using a computer system that has a mobile voucher manager of the mobile voucher unit, a new deal having a purchase price, a redemption value and a discount of the new deal for a particular merchant;

syndicating, using the computer system that has the mobile voucher manager of the mobile voucher unit, the new deal to a plurality of consumers to determine a level of interest of the plurality of consumers wherein an interested user participates in the new deal;

presenting, using the mobile voucher manager of the mobile voucher unit, the new deal to the particular merchant, for approval, when a deal threshold is met;

providing, using the mobile voucher manager of the mobile voucher unit, when the merchant accepts the new deal, a digital voucher to the consumer computing device of each user who participated in the new deal; and

proving a[ ] merchant in-store redemption of the digital voucher by the user of each consumer computing device.

REJECTIONS

Claims 1–46 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 3, 8, 9, 17, 19, 24, 25, 33, 34, 38, and 39 are rejected under 35 U.S.C. § 102(e) as anticipated by Mason et al. (US 2011/0313840 A1, pub. Dec. 22, 2011) (hereinafter "Mason").

Claims 2, 6, 7, 18, 22, 23, and 37 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mason and Zhang et al. (US 2008/0281692 A1, pub. Nov. 13, 2008) (hereinafter "Zhang").

Claims 4, 5, 20, 21, 35, and 36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mason and Boyd et al. (US 2004/0193489 A1, pub. Sept. 30, 2004) (hereinafter "Boyd").

Claims 10–16, 26–32, and 40–46 are rejected under 35 U.S.C. § 103(a) as unpatentable over Mason and Jokinen et al. (US 2002/0095333 A1, pub. July 18, 2002) (hereinafter "Jokinen").

ANALYSIS

Non-Statutory Subject Matter

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *See, e.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* 566 U.S. 66 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 566 U.S. at 79–80).

The Court acknowledged in *Mayo*, that "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine "whether their character as a whole is directed to excluded subject matter." *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner finds that the claims are directed to "marketing of products by creating [a] new promotional offer, approving the new offer, presenting the electronic offer to the consumer's mobile device, and redeeming the offer"; that "[m]arketing . . . products using [a] digital offer" is a fundamental economic practice or a conventional business practice and, therefore, an abstract idea; that the claims do not include limitations that are "significantly more" than the abstract idea because the claims do not include an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment; and that the limitations, beyond the abstract idea, are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the industry (Ans. 3–4).

Focusing on the first step of the *Mayo/Alice* framework, Appellants argue that the rejection under § 101 should be withdrawn because the claims are not directed to an abstract idea and "clearly do not 'tie up' the idea of 'marketing of products'" (Reply Br. 5). That argument is not persuasive at least because preemption is not the test for patent-eligibility.

There is no dispute that the Supreme Court has described "the concern that drives [the exclusion of abstract ideas from patent-eligible subject matter] as one of pre-emption." *Alice Corp*, 134 S. Ct. at 2354. But characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. "The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability" and "[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis." *Arioso Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice*, 134 S. Ct. at 2354). Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.*

Turning to the second step of the *Mayo/Alice* framework, Appellants summarily assert even if the claims are directed to an abstract idea, the claims recite additional elements that amount to significantly more than the judicial exception (Reply Br. 6). But Appellants provide no persuasive argument or technical reasoning to support that assertion. Indeed, Appellants fail to even identify the additional elements that allegedly amount to significantly more than the abstract idea.

We are not persuaded on the present record that the Examiner erred in rejecting claims 1–46 under 35 U.S.C. § 101. Therefore, we sustain the Examiner's rejection.

Anticipation

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claims 1, 17, and 33 under 35 U.S.C. § 102(e) because Mason does not disclose "a mobile voucher manager that creates a new deal having a purchase price, a redemption value and a discount of the new deal for a particular merchant, . . . [and] presents the new deal to the particular merchant, for approval, when a deal threshold is met," as recited in independent claim 1, and similarly recited in independent claims 17 and 33 (App. Br. 6–7; *see also* Reply Br. 7–8).

Mason is directed to a discount retailing system and method, and discloses that the system provider may solicit vendors for participation in the system; alternatively, vendors may approach the system provider, without being solicited, and request to have their products or services offered to customers via the discount retailing system (Mason ¶ 86). Mason discloses that, in accordance with the method, a product or service (which can be any product sold or distributed by the vendor or any service provided by the vendor) is identified for a discount offering (*id.*), and the terms of the offer are determined (*id.* ¶¶ 41, 43). The discount offer is then published, e.g., through an Internet website, and consumers accept the offering, e.g., by "signing up" for the offer on the website (*id.* ¶ 88). Mason discloses that a "tipping point" may be defined for the offer, which is the minimum quantity of the good or service that must be accepted by consumers in order to execute the sale of the good or service (*id.* ¶¶ 45, 87). For example, Mason describes that XYZ Restaurant, which participates in the discount retailing system, may provide a 50% discount offering with a tipping point established at 25; thus, if only 24 people accept the discount offer, the offer is abandoned and no consumer receives the discount (*id.* ¶¶ 90, 91; *see also id.* ¶ 28).

In rejecting claims 1, 17, and 33, the Examiner cites paragraphs 4, 28, 41, 43, 45, 88, and 91 of Mason as disclosing the argued limitations (Final Act. 7–8). Responding to Appellants' arguments in the Answer, the Examiner further cites Mason's disclosure of an exchange program, i.e., a secondary market, in which customers may offer to sell or exchange their purchased deals for money, loyalty points, or deals owned by other customers, or place the purchased deals on the exchange and let others bid on them (Ans. 5–6).[3] The Examiner also cites Mason's disclosure of so-called G-Points, which Mason discloses may be collected and redeemed at a level of one point per one cent such that a consumer purchasing a discount offer for $5.00 collects 500 G-points, which the consumer may later redeem at a "G-store" for a discount offer, again at the level of one point per one cent (*id.* at 6).[4]

We have carefully reviewed the cited portions of Mason, on which the Examiner relies. And we agree with Appellants that there is nothing in these portions of Mason that discloses that a mobile voucher manager, e.g., a discount retailing system or a system provider, creates a deal having a

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[3] The Examiner does not identify the relied-on portions of Mason, e.g., by paragraph number. However, the exchange program is described, for example, at paragraphs 100–105 of Mason.

[4] G-Points are described, for example, at paragraphs 95 and 96 of Mason.

purchase price, a redemption value and a discount for a particular merchant, and then presents the new deal to the particular merchant, for approval, when a deal threshold is met. The best that Mason discloses is that the terms of the deal, i.e., the discount offering, including the tipping point, may be determined by the vendor, the system provider, and/or the discount retailing system (Mason ¶ 87). But we find nothing in the cited portions of Mason that discloses that the discount offering is presented to the vendor for approval after the deal threshold, i.e., the tipping point, is met. Instead, Mason discloses that when the tipping point is reached, settlement may occur thereafter, i.e., the consumer is then charged the offer price (*id.* ¶ 28).

In view of the foregoing, we do not sustain the Examiner's rejection of independent claims 1, 17, and 33 under 35 U.S.C. § 102(e). For the same reasons, we also do not sustain the rejection of dependent claims 3, 8, 9, 19, 24, 25, 34, 38, and 39.

Obviousness

Each of claims 2, 4–7, 10–16, 18, 20–23, 26–32, 35–37, and 40–46 depends, directly or indirectly, from one of independent claims 1, 17, and 33. The rejections of these dependent claims do not cure the deficiencies in the Examiner's rejection of independent claims 1, 17, and 33. Therefore, we do not sustain the Examiner's rejections of dependent claims 2, 4–7, 10–16, 18, 20–23, 26–32, 35–37, and 40–46 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1–46 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1, 3, 8, 9, 17, 19, 24, 25, 33, 34, 38, and 39 under 35 U.S.C. § 102(e) is reversed.

The Examiner's rejection of claims 2, 4–7, 10–16, 18, 20–23, 26–32, 35–37, and 40–46 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED